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Paper No. 11

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In re Application of
Evi Kostenis
Application No. 09/899,295
Filed: July 6, 2001
Attorney Docket No. 2481.1745DECISION GRANTING
PETITION

This is a decision on the petition filed December 10, 2001, requesting that the above-identified application be accorded a filing date of July 6, 2001 with Figures 1-7 as part of the original disclosure.

On July 6, 2001, the above-identified application was deposited. The application included, *inter alia*, 50 pages of specification including 170 claims, a transmittal letter (3 pages), a check for the filing fee, and a certified copy of German Patent Application No. 10033352.2 to which a claim for foreign priority under 35 U.S.C. 119 is stated on the second page of the transmittal letter. No drawings other than the drawings contained in the German priority document accompanied the original application papers. Accordingly, on September 18, 2001, the Initial Patent Examination Division mailed a "Notice of Incomplete Nonprovisional Application" requiring drawings necessary for an understanding of the invention and an executed oath or declaration covering the drawings. The Notice stated that the filing date would be the date of receipt of the missing drawings.

In response, on November 19, 2001, petitioner submitted, *inter alia*, seven (7) sheets of drawings containing Figures 1-7 and an executed declaration and surcharge together with a paper styled "Response to Notice of Incomplete Nonprovisional Application." The response requested that the "drawings be made of official record in the above-identified application." The application was accorded a filing date of November 19, 2001 based on the seven sheets of drawings petitioner submitted that day.

On November 29, 2001, the Initial Patent Examination Division mailed a "Notice to File Corrected Application Papers" stating that the application has been accorded a filing date of November 19, 2001 and requiring substitute drawings in compliance with the margin requirements of 37 CFR 1.84.

Docketed 2-5-02 Attorney CPE/DSF/EAO/MSOCase 2481.1745Due Date 4-1-02 WELTAction DECL 2001By JFEB 05 2002
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On December 10, 2001, inter alia, the present petition including an authorization to charge the present petition fee to counsel's deposit account was filed. In a telephone communication with USPTO Legal Advisor, James Engel, petitioner was informed of a delay in locating the petition. In response, a copy of the petition was supplied by facsimile on December 14, 2001. Prior to mailing this decision the original petition was located and placed in the application file.

Petitioner requests that the application be accorded a filing date of July 6, 2001 with Figures 1-7 as part of the original disclosure. In support, petitioner cites the fact that Figures 1-7 were present in the German priority document that accompanied the original application papers deposited in the Office on July 6, 2001.

A review of the record reveals that the German priority document includes a specification, claims and seven (7) sheets of drawings containing Figures 1-7. The present petition is accompanied by a copy of those drawings. It is noted that the seven sheets of drawings submitted with petitioner's November 19, 2001 response is also based on a copy of the drawings from the German priority document.

Seven sheets of drawings containing Figures 1-7 are included in the German priority document that was present among the original application papers deposited on July 6, 2001. Accordingly, on petition, a copy of those drawings will be construed as the drawings necessary for this application for filing date purposes.

In view of the above, the petition is granted. The seven sheets of drawings submitted with the petition will be used as the drawings for filing date purposes.

The drawings submitted on November 19, 2001 are considered withdrawn and will not be entered or used during the prosecution of this application.

Since the drawings that were evaluated for compliance with the requirements of 37 CFR 1.84 are withdrawn, the Notice mailed November 29, 2001 is hereby vacated.

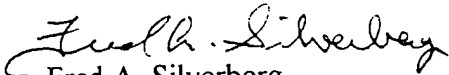
A review of the declaration that accompanied the November 19, 2001 response reveals that it specifically references the application specification, as filed, to the exclusion of any reference to the drawings. Therefore, the declaration does not execute the application including the seven sheets of drawings. Accordingly, a newly executed oath or declaration in compliance with 37 CFR 1.63, referencing the entire application (including the drawings), and identifying the specification to which it is directed is required.

Applicant is given TWO MONTHS from the date of this decision to file the oath or declaration complying with 37 CFR 1.63 and referencing the drawings as required above in order to avoid abandonment of the application. This time period may be extended pursuant to 37 CFR 1.136(a). The response should be directed to the attention of the Initial Patent Examination Division.

The application is being returned to Office of Initial Patent Examination for:

- (1) correction of the filing date to July 6, 2001, using the application papers filed July 6, 2001, and the seven sheets of drawings containing Figures 1-7 supplied December 10, 2001;
- (2) an indication in the bibliographic data for this application that seven (7) sheets of drawings were present on filing, and
- (3) awaiting any oath or declaration in response to this decision.

Any inquiries related to this decision should be directed to Legal Advisor James Engel at (703) 308-5106.



Fred A. Silverberg
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

JJE